



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,072	04/15/2005	Mauro Maritano	05788.0312	7161
22852 7590 08/08/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER GRAY, JILL M	
			ART UNIT 1774	PAPER NUMBER
			MAIL DATE 08/08/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/500,072

Applicant(s)

MARITANO ET AL.

Examiner

Jill M. Gray

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/25/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The examiner has considered the references cited on the IDS and in the specification.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, in claim 1, line 2, the language of "said element" is vague and indefinite because it is not clear if this language refers to the elongated element or the transmitting element. Also, the phrase "preferably" renders the claim indefinite because it is not clear if the limitations following this phrase are part of the claim or not.

Accordingly, the metes and bounds for which patent protection is being sought are not clear.

Claims 2-21 do not alleviate the concerns of claim 1 and thus are indefinite for the reasons stated above.

Art Unit: 1774

Claim 13 is also indefinite due to the presence of the phrase "preferably" because it is not clear if the limitation following this phrase are part of the claim or not.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1774

7. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anelli et al, 6,577,796 B2 and PCT Publication WO 00/21098, (hereinafter referred to collectively as Anelli) in view of Uemura et al, 5,134,036 (Uemura).

Anelli discloses a telecommunications cable comprising an elongated element housing at least one transmitting element, said element comprising a water-soluble polymer material such as vinyl alcohol/vinyl acetate copolymer, as required by claim 1. See for example abstracts and entire documents. In addition, the elongated element is a tubular element comprising at least one sheath made from said water-soluble polymer material, comprising a double layer sheath in which the inner sheath is made from a water-soluble polymeric composition and the outer sheath is made from a conventional water-insoluble composition, and further comprising a third outer sheath made from water-soluble polymer material, as required by claims 18-20. Alternatively, Anelli discloses that the elongated element is a grooved core comprising at least one groove longitudinally disposed on the outer surface of said core, as required by claim 21. See for example '796, column 4, lines 35-62. As to the specific composition of the water-soluble polymer material, Anelli discloses that his composition can contain conventional additives such as plasticizers and stabilizers, wherein at least 5% of the total weight of the composition is plasticizer, and can range from about 1% to about 30% by weight as required by claims 10-11. Additionally, Anelli discloses that the copolymer is present in amounts of at least 50% by weight and more than 75% by weight, per claims 8-9. See for example '796 column 10, lines 17-40 and column 17, lines 12-27. Anelli is silent as to the specific conventional stabilizers that can be used.

Uemura teaches a composition comprising ethylene vinyl alcohol copolymer and vinyl acetate (column 5, lines 12-21). Said composition comprises known conventional stabilizer compound of the type contemplated by applicants, wherein the copolymers has a degree of saponification within the instant claimed range. Note column 3, line 35 through column 4, and line 13.

Regarding claims 1, 6-7, and 12-17 it would have been obvious to one having ordinary skill in the art to modify the copolymer of Anelli by using as the conventional stabilizer, any conventional stabilizer known in the art, such as and including those taught by Uemura, in order to reduce oxidation and thermal degradation. Moreover, these claims would have been obvious because the substitution of one known stabilizer for another would have yielded predictable results to one of ordinary skill in the art at the time the invention was made. Accordingly, it is the examiner's position that a patent cannot be granted for an applicants' discovery or a result, even though it may be unexpectedly good, which would flow logically from the teaching of the prior art. *In re Rau*, 117 USPQ 215 (CCPA 1958).

Regarding claims 2-5, it is the position of the examiner that the discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art.

Therefore, the combined teachings of Anelli and Uemura would have rendered obvious the invention as claimed in present claims 1-21.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

Art Unit: 1774

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-7 and 10-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 29-30 of U.S. Patent No. 7,155,094 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the broad requirement of "a plasticizer" of the present claims would render obvious the plasticizer of the patented claims.

No claims are allowed.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

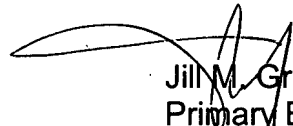
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524.

The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

Art Unit: 1774

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton I. Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jill M. Gray
Primary Examiner
Art Unit 1774

jmg